

R E M A R K S

Applicants note that all amendments and cancellations of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),¹ and without waiving the right to prosecute the amended or cancelled Claims (or similar Claims) in the future.

In the Office Action dated 03/29/06, for claims 3 and 4, the Examiner required further election of a single gene or combination of genes referenced in claims 3 and 4. Applicants believe that the original claims set forth the combination of genes. However, for clarity, claim 3 has been amended to specify that each of the recited genes is analyzed to generate a profile (i.e., the profile contains information about the presence or absence of methylation for all of DAPK, GSTP, p15, MDR1, Progesterone Receptor, Calcitonin, RIZ, and RARbeta genes). Thus, the presently claimed invention is not the analysis of a single gene, but the analysis of the recited combination of genes to provide useful information. With respect to claim 4, which specifies that at least one of S100, SRBC, BRCA, HIN1, Cyclin D2, TMS1, HIC-1, hMLH1E-cadherin, 14-3-3sigma, and MDGI are further analyzed (i.e., the full set of genes of claim 3 plus at least one from claim 4 is analyzed), Applicants elect 14-3-3 sigma. Applicants believe that the restriction with respect to claim 4 should be treated as a species election, since the allowability of claim 3, from which claim 4 is dependent, will necessarily grant novelty and non-obviousness to claim 4, which includes all of the limitations of claim 3.


The Examiner has requested that Applicants provide an indication where the sequences of the recited genes are provided in the application. The genes recited in the claims are all known genes. As such, the sequences are not expressly recited in the specification. A description of publications describing some of the genes is found on pages 82-83 of the specification. Applicants direct the Examiner to the OMIM (Online Mendelian Inheritance in Man) public database (<http://www.ncbi.nlm.nih.gov>) for reference to these known genes, their sequences, as well as their alternative names and nomenclatures.

¹ 65 Fed. Reg. 54603 (Sept. 8, 2000).

CONCLUSION

Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the applicant encourages the Examiner to call the undersigned collect at (608) 218-6900.

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